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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,498	02/05/2001	John Michael Jensen	8025P001	9282
8791 7590 10/01/2009 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER				
VIG, NARESH				
ART UNIT		PAPER NUMBER		
3629				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/776,498

Applicant(s)

JENSEN, JOHN MICHAEL

Examiner

NARESH VIG

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is in reference to communication received 01 July 2009. Claims 21 – 46 are pending for examination.

Declaration Under 37 C.F.R. 1.131

The Declaration Under 37 CFR 1.131 filed 04 June 2009 to overcome the rejection of claims 21 – 46 based on John Cook newspaper article "Well-Funded Xpertsite.com Making Hay With Its Popular Answer Service" in view of archived web pages of Keen.com. On page 2 of the declaration, Applicant has stated that the invention was conceived prior to 20 April 2000, and provided exhibits 1 – 9. Applicant also stated that Between 20 April 2000 and 09 August 2000, researched best manner of implementing and describing the invention, and on 09 August 2000, applicant wrote the "Patent Method" which is presented as Exhibits 10 - 11. The statement and exhibits provided by the applicant does not demonstrate that the concept of the limitations in the claimed invention

- contact information of the receiver is hidden from the communication device
- identification information of the user is tracked from the text communication from the receiver.

were conceived prior to 20 April 2000.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Also, cited reference John Cook newspaper article "Well-Funded Xpertsite.com Making Hay With Its Popular Answer Service" article states that Xpertsite.com was co-founded by Ramesh Parameswaran in August. A Business Week article "Outta Here at Microsoft" dated 29 November 1999 also states that in August 1999, Ramesh Parameswaran quit Microsoft to start XpertSite.com.

Response to Arguments

Applicant's arguments and concerns for amended claims have been responded to in response to the pending amended claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21 – 46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's disclosure does disclose

how the identification of the user is tracked for a return text communication from the receiver. For example, how plurality users with common name like John Smith is tracked so that the return text communication from the receiver is provided to the proper user.

how is the communication via physical mail exchanged between the user and the receiver.

how is the communication is exchanged between the user and the receiver when the contact information of the receiver is an account

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21 – 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As currently claimed, it is not clear:

how a user makes a selection of a receiver to receive text, is the user provided with a list of receivers?

whether the return text communication from the user is even provided to the proper user who paid the fee

during the transmission of the text from the transmission text from the communication device to the receiver through the intermediary facility, how it the text

transmitted to the receiver, when the contact information of the user is not know to the communication device.

how is the communication via physical mail exchanged between the user and the receiver.

how is the communication is exchanged between the user and the receiver when the contact information of the receiver is an account

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 – 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over John Cook newspaper article "Well-Funded Xpertsite.com Making Hay With Its Popular Answer Service" hereinafter known as Cook in view of previously cited archived web pages of Keen.com hereinafter known as Keen.

Regarding Claims 21, 31 and 39, as best understood by examiner, Cook teaches system and method for connecting a communication device with an intermediary facility (Xpertsite.com). Cook does not explicitly teach selecting a receiver to receive text.

However, Cook teaches Keen.com as one on the competitors of Xpertsite.com. Keen teaches idea of selecting a receiver to receive text;

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cook as taught by Keen to allow the user to select a consultant of their choice, apply a known technique to a known device (method, or product) ready for improvement to yield predictable results.

Cook in view of Keen teaches concept for:

transferring a fee from a user [Keen, page 12];

transmitting the text from the communication device to the receiver through the intermediary facility (Keen teaches the concept wherein the phone number, email information of the users are hidden) [Keen, page 10, 14]

wherein text is transmitted from the communication device by a user to a receiver through the intermediary facility for a fee paid by the user [Keen, page 10, 11], and the contact information of the receiver is hidden from the communication device [Keen, page 10], and identification information of the user can be tracked for a return text communication from the receiver [Keen, page 11].

Regarding Claims 22, Cook in view of Keen teaches concept wherein the intermediary facility is a server.

Regarding Claims 23, 33 and 41, Cook in view of Keen teaches concept wherein the text is transmitted as an electronic mail (e-mail) message [Keen, page 14].

Regarding Claims 24, 34 and 42, Cook in view of Keen teaches concept wherein the receiver can be a publicly known person.

Regarding Claims 25, 35 and 43, Cook in view of Keen teaches concept wherein the contact information can be an account.

Regarding Claims 26, 36 and 44, Cook in view of Keen teaches concept wherein the receiver receives a benefit by receiving the text and the benefit is personal benefit.

Regarding Claims 27 and 37, Cook in view of Keen teaches concept wherein the text is transmitted on a network.

Regarding Claims 28, 38 and 45, Cook in view of Keen teaches concept wherein the communication device receives a confirmation of delivery of the text, and the confirmation of delivery can be received as an e-mail.

Regarding Claims 29 and 46, Cook in view of Keen teaches concept wherein the confirmation of delivery can be received as an e-mail.

Regarding Claims 30, 32 and 40, Cook in view of Keen teaches concept wherein the fee is paid for by a user of the communication device, and the fee is paid to an account of the intermediary facility.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Outta Here at Microsoft

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NARESH VIG whose telephone number is (571)272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 30, 2009

/Naresh Vig/
Primary Examiner, Art Unit 3629